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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,650	06/20/2001	Matthew John Bending	67097-004	4180

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,650

Applicant(s)

BENDING, MATTHEW JOHN

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/20/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The identifying code to which the applicant refers in claims 3, 12, and 13 is not mentioned in the specification.

Claim Rejections - 35 USC § 112

2. Claims 3, 4, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the Specification, the applicant talks about using the system without registering (Page 3, Lines 17 and 29). In the above claims, applicant talks about a user accessing the site only after registering. Therefore, the claim scope is unclear.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9 are rejected under 35 U.S.C. 101 because the claims are not "within the technological arts." The inclusion of a computer to input, transmit or output data is taken as a trivial recitation of technology which is not enough to put the claims within the

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technological arts. Applicant must include a non-trivial computer limitation (e.g. a calculation) in the body of the claims. The examiner suggests specifying a computer as providing the information system and booking capability in claim 1. See below for the basis for this rejection.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis: The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377.

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Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5, 7, 8, 10, 11, 15, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Eller (U.S. Pub. No. 2002/0116717). Eller shows a system and method for rental of advertising space that includes all of the limitations recited in the above claims.

7. Referring to claims 1 and 10, Eller teaches a method and system for the rental of advertising space in facilities (the billboard can be located indoors)(Paragraph 0022, Sentence 3) that comprises: providing an information system which comprises a database that contains stored data upon a plurality of facilities which have space available for advertising and promotional purposes (Paragraph 0025, Sentence 2); allowing access to the database by users so that they may review the stored data

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(Paragraph 0025, Sentence 1) and select at least one facility where they wish to use the available advertising space (Paragraph 0026, Sentence 1); and providing a booking capability on the system such that the advertising space at the at least one facility may be booked by the user (Paragraph 0027, Sentence 1). The use of computers and servers (Paragraphs 0004 and 0005) to perform these steps is sufficient in describing a memory device storing a program and a processor in communication with said memory, as stated in claim 10.

8. Referring to claims 2 and 11, Eller teaches the step of providing an introduction capability on the system such that the user and the owner of the at least one selected facility may be put in contact with one another (Paragraph 0025, Sentence 2). The providing of a facility location satisfies the introduction capability required in these claims.

9. Referring to claim 5, Eller teaches the step of providing a search capability on the system so that a user may search for facilities whose data matches the requirements of that user (Paragraph 0025, Sentence 2).

10. Referring to claims 7 and 15, Eller teaches the stored data as being geographical location (Paragraph 0025, Sentence 2)

11. Referring to claims 8 and 16, Eller teaches the user accessing the system via the internet (Paragraph 0025, Sentence 2).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 4, 9, 12-14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eller (U.S. Pub. No. 2002/0116717).

As best understood, regarding claims 3, 4, and 12-14, Eller teaches a user using an account with a password to pay for any ordered advertising. Eller doesn't teach the providing of a code when a user first accesses the system, and Eller also doesn't teach the user accessing the information system only with a code. (Paragraph 0027, Sentence 2). Official notice is taken that it is well known to password protect an information system and log in would be required upon initial access. It would have been obvious to one having ordinary skill in the art at the time the invention was made to password protect Eller's entire system from the start, allowing the user to obtain a username and password upon first accessing the site. This would allow for greater security over the entire system.

Regarding claims 9 and 19, Eller specifies a store as a possible billboard facility (Paragraph 0022, Sentence 3). Eller doesn't specifically teach the electronic billboards as being located within a shopping mall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the invention of Eller

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within a store located within a shopping mall. This would allow mall stores to receive added revenue from electronic billboards along with freestanding stores.

14. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eller (U.S. Pub. No. 2002/0116717) in view of Unold (U.S. Pub. No. 2002/0055880).

Eller teaches the advertiser of the billboard system as having secure access to the server, but facility owner access is not specified. Unold teaches site owners as having separate access to the billboard system than that of advertisers (Abstract, Sentence 2). The system of Unold is taken to be an intranet. Also, since the access that advertisers have to Eller's system is secure, it would have been obvious to secure facility owner access as well. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give facility owners of Eller's system secure intranet access to the system. This would allow facility owners to control pricing and content of their individual billboards.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eller (U.S. Pub. No. 2002/0116717) in view of Thomson (U.S. Pub. No. 2003/0061104).

Eller doesn't teach a system comprising a telephone help center. Thomson teaches an internet-based system that provides a toll-free telephone number to an expert call center. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a telephone help center in Eller's system. This would allow for improved customer service should complications arise in the booking process.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to online rental databases:

U.S. Patent No. 5,680,305 to Apgar

U.S. Patent No. 6,871,140 to Florance

U.S. Pub. No. 2001/0037280 to Ingraham

The following references are cited to further show the state of the art with respect to advertising space rental:

U.S. Pub. No. 2004/0036622 to Dukach


U.S. Pub. No. 2002/0095334 to Kao

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER